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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,886	12/21/2004	Glenn Edward Jones	2002B096/2	3493

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EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/518,886

Applicant(s)

JONES ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE OF 8-31-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-18,20-33,35-41 and 43-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-18,20-33,35-41 and 43-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 9-18, 20-33, 35-41 and 43-50 are rejected under 35 U.S.C. 102(a) or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsou et al. (either US 6,875,813 or WO 200157340).

Patentees ('813 available under paragraph "e" of 35 USC 102 which corresponds to the above PCT patent) disclose a composition having isobutylene elastomers and semicrystalline polymers (abstract) which include combinations of brominated butyl rubber and Exxon Exact plastomer respectively carbon black and curing agent (see the examples in Table 1). Natural rubber may be added at column 6, lines 9-21 and polybutene oil may be added at column 6, lines 56-66.

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When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428; 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 and 9-50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,875,813.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the generic terms recited by the patent claims are disclosed to

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include applicants specific species by the patent specification which thus supports the patent claims and is therefore properly relied on.

Claims 1-7, 9, 10 and 24-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simonutti et al (US 6030304) in view of Coran (US 4,130,534).

Simonutti et al (US 6030304) disclose a composition having a rubber and plastomer (abstract) wherein said rubber includes butyl rubber (column 2, lines 16-25). Note that the examples use fillers and curing agents.

The primary reference does not disclose use of extender oil Coran however discloses an elastoplastic composition and that extender oil is "desirable" to improve processability and other properties (column 8, lines 38-53 and 15-20).

Use of extender oil in the composition and process of the primary reference would have been obvious to a practitioner having an ordinary skill in the art at time of the invention as taught by Coran motivated to improve properties, absent any showing of surprising or unexpected results.

With re to applicants maximum brittle temperature characteristic, Simonuttis materials have glass transitions for below minus 41 degrees centigrade and would be expected to be even further depressed by oil and Simoniuttis' compositions and obvious variations thereof as set out above would therefore be expected to have applicants brittle temperature.

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Ekdahl et al. at column 4, lines 55-59 discloses that polyethylene has a glass transition of minus 120 degrees while polypropylene has a Tg of minus 10 degrees.

Kennedy, newly cited discloses at column 4, lines 62-67 that polyisobutylene has a Tg of minus 65 while Arens has a similar disclosure at column 4, lines 6-10.

Applicant's arguments filed 9-6-06 have been fully considered but they are not persuasive. With re to applicants brittleness value characteristic such is considered inherent in Tsou et al given that the reference otherwise discloses all of applicants other limitations explicitly.

With re to Simonutti, assuming that the results obtained with the specific composition of Tsou could be extrapolated to Simonutti, Tsou' Example 4 shows a combination of high air permeability and low die swell (i.e. high processability). In any case more to the point is what those skilled in the art would assume would result from the proposed modification to the primary reference (i.e. addition of oil). Note in this re Pazur and Mohammed at column 4, lines 56-58 and column 3, lines 58-61 respectively which disclose that it is known in the art that addition of oil to butyl rubber vulcanizates increases air permeability. Applicants remarks appear to deal with the examiner's prima facie case of obviousness. However, even if the examiner was incorrect re his position that those skilled in the art would expect higher air permeability, those practitioners desiring higher processability would be motivated do so by adding oil to the composition of the primary reference absent any showing that such addition would render air permeability characteristic of the resulting product unusable for the purpose of the

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primary reference. With re to unexpected results, such must be with the closest prior art and no data comparative to the closest prior art have been presented

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

9-15-06

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, appearing to be 'JCM', located below the printed name and title of Jeffrey Mullis.